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Albin H. Gess  
Price Gess & Ubell  
2100 SE Main Street  
Suite 250  
Irvine, CA 92614

In re Application of	:	
HOLMES et al.	:	
U.S. Application No. 09/446,296	:	DECISION ON PETITION
PCT No.: PCT/GB98/01798	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 18 June 1998	:	
Priority Date: 18 June 1997	:	
Attorney Docket No.: GIL4-BJ18	:	
For: METHOD AND APPARATUS FOR	:	
GENERATING A DISPLAY SIGNAL	:	

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 10 October 2000 to accept the application without the signature of joint inventors, Steven Holmes and David J. Wright. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

### BACKGROUND

On 18 June 1998, applicants filed international application PCT/GB98/01798 which claimed a priority date of 18 June 1997 and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 December 1998. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 18 December 1999.

On 25 May 2000, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a first preliminary amendment.

On 29 September 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 10 October 2000, applicants filed "Response to Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office," a declaration and power of attorney signed by two of the four joint inventors, and a petition under 37 CFR 1.47(a) and the requisite fee.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after

diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4).

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

"Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration."

#### *Refusal of Joint Inventor David J. Wright*

A review of the present petition and the accompanying papers reveal that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to David J. Wright. The declaration of Bianca Stuchfield states that "[o]n 22 November 1999 (and 06 December 1999), I personally sent application forms to Mr. Wright . . . The forms sent to Messrs. Wright and Holmes on each occasion included the U.S. Declaration form and an Assignment." The declarant fails to state what application papers were sent to the missing inventor. Was a complete application (specification, claims, and drawings) mailed to the missing inventor? Was the complete application returned undeliverable?

#### *Refusal of Joint Inventor Steven Holmes*

A review of the present petition and the accompanying papers reveal that applicants have not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Steven Holmes. The declaration of Bianca Stuchfield states that "[o]n 22 November 1999 (and 06 December 1999), I

personally sent application forms to Mr. Wright . . . The forms sent to Messrs. Wright and Holmes on each occasion included the U.S. Declaration form and an Assignment." The declarant fails to state what application papers were sent to the missing inventor. Was a complete application (specification, claims, and drawings) mailed to the missing inventor? Additionally, Ms. Stuehfield states that, "[o]n 07 December 1999, I received a letter from Mr. Holmes...that he was not prepared to sign the 'assignments.'" The refusal to sign the assignment is not a refusal to execute the application.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Messrs. Wright and Holmes and when such papers were sent and that Messrs. Wright and Holmes have subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of Messrs. Wright and Holmes under 37 CFR 1.47(a) at this time.

#### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



Leonard E. Smith  
PCT Legal Examiner  
PCT Legal Office



Anthony Smith  
Petitions Attorney  
PCT Legal Office  
Tel.: 703-308-6314  
Facsimile: 703-308-6459